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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,875	07/09/1999	JAY S. WALKER	WD2-98-113	8896

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EXAMINER
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O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 03/15/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/350,875

Applicant(s)  
Walker et al.

Examiner  
O'Connor

Art Unit  
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on January 15, 2002 (Election and Amendment "A").
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 32, and 57-71 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 32, and 57-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 & 12 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of the invention of Group I, claims 1-15, 32, and 57-71, in Paper N<sup>o</sup> 13 is hereby acknowledged.
2. The cancellation of claims 16-31 and 33-56 by applicant in Paper N<sup>o</sup> 13 is hereby acknowledged.

### ***Claim Objections***

3. Amended claim 3 is objected to for failure to comply with 37 CFR 1.121(c)(1)(ii), which requires that all changes being made to a claim be indicated. In the instant case, applicant has failed to indicate that "completed before" has been changed to --performed after--. Appropriate correction is required.
4. Claim 32 is objected to because of the following informality: it appears that applicant's recitation, "purchase" (line 13), was intended to be --purchased--. Appropriate correction is required.

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***Claim Rejections - 35 USC § 101***

5. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-15, 32, and 57-71 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-15, 32, and 57-71 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 112, Second Paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 63 and 65-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 63, while applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*,

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161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term “threshold” in claim 63 is used by the claim to mean “range,” while the accepted meaning is “minimum.”

Regarding claims 65-66, it is unclear what element applicant is attempting to claim with the recitations of “pricing tier,” where it appears that nothing more has been disclosed or is being claimed than merely a first “price” and a second “price” for each product, under any particular set of circumstances.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-15, 32, and 57-71, as best understood, in light of any rejections made under 35 U.S.C. 101 and 35 U.S.C. 112, hereinabove, are rejected under 35 U.S.C. 102 as being clearly anticipated by the admitted prior art, as described in the specification and drawings. In making this rejection, note that the various store embodiments recited (store, website, catalog, etc.) and so forth, have been deemed merely “for use” applications of the claimed “method of calculating a purchase total for a transaction,” hence, afforded little patentable weight.

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11. Claims 1-15, 32, and 57-71, as best understood, in light of any rejections made under 35 U.S.C. 101 and 35 U.S.C. 112, hereinabove, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by each of Dlugos (U.S. 5,444,630) and Schultz et al. (U.S. 5,056,019). In making this rejection, note that the various store embodiments recited (store, website, catalog, etc.) and so forth, have been deemed merely "for use" applications of the claimed "method of calculating a purchase total for a transaction," hence, afforded little patentable weight.

***Conclusion***


12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525.

GJOC



March 12, 2002

 3/13/02  
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